

Remarks

In the Office action dated April 19, 2004, claims 1, 7-10, and 39-47 were rejected under 35 U.S.C. § 103 as being unpatentable over McCarty et al. (U.S. Pat. No. 5,946,660) and Joao (U.S. Pat. No. 6,347,302) in view of Denny et al. (U.S. Pat. No. 5,724,261). The Applicant respectfully disagrees with the Office's position and submits that the subject matter of the pending claims is not taught or suggested by any of these references. Claims 4, 5, and 6 were also rejected under 35 U.S.C. § 103 as being unpatentable over McCarty et al. (U.S. Pat. No. 5,946,660), Joao (U.S. Pat. No. 6,347,302), and Denny et al. (U.S. Pat. No. 5,724,261) and in view of "Official notice."

The subject matter of a patent claim may be rejected, even though the subject matter is not identically disclosed or described in a single prior-art reference, if the subject matter as a whole would have been obvious to one of ordinary skill in the art. 35 U.S.C. § 103. To determine whether claimed subject matter is obvious, the scope and content of the prior art and the differences between the prior art and the claims at issue must be determined. Graham v. John Deere, 383 U.S. 1 (1966). Furthermore, the combination of prior art or prior art teachings used to support an obviousness rejection must be a combination where there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. In re Vaeck, 947 F.2d 488, 493, 20 U.S.P.Q. 2d 1438, 1442 (Fed. Cir. 1991). The requisite motivation to combine references may not be derived from the Applicant's disclosure. MPEP § 2143. The mere fact that the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. In re Mills, 916 F.2d 680, 682, 16 U.S.P.Q.2d 1430, 1432 (Fed. Cir. 1990); MPEP § 2143.01.

A proposed modification to a prior-art reference cannot render the prior art invention unsatisfactory for its intended purpose or change the principle of operation of the prior art invention. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959), MPEP § 2143.01. If the proposed modification destroys the intended purpose or principle of operation of the prior art reference, then there is no suggestion or motivation to make the proposed modification and the teachings of the references are not sufficient to render the claims obvious. Id.

The claims at issue are not obvious because there is not a suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify McCarty et al. or to combine the teachings of McCarty et al. with Joao or Denny et al. Rather, the proposed modification of the prior-art references makes them unsatisfactory for their intended purpose and changes the principles of operation of the prior art devices.

McCarty discloses a fully automated interactive kiosk used to rent storage space "without the need for an attendant" (see Abstract; col. 1, lines 15-16; col. 2, lines 22-24; col. 3, line 43). The kiosk allows storage space to be rented at a plurality of locations and at any time of the day. A customer provides information to a processor regarding the desired location of the storage unit. The processor then causes all available storage units at that location to be displayed. The customer does not indicate or input his or her storage needs to the kiosk and the kiosk does not make any recommendations. The explicit goal of the kiosk is to reduce overhead at rental facilities by eliminating the need for an attendant and to eliminate the need for a rental building.

McCarty is substantially different than the claimed subject matter, which requires communication with a manager. In direct apposition to the concept of a fully automated system as taught by McCarty, the claimed manager is involved in multiple aspects of the rental transaction. The remote manager recommends a storage unit to the customer based upon expressed needs, facilitates inspection of the recommended unit, and directs the customer how to fill out portions of the rental agreement. McCarty teaches away from involving a manager or other person in the transaction. McCarty provides a system that is "fully automated so as to eliminate the need for an on-duty attendant." (See Col. 4, lines 22-24). By requiring the interaction of a manager or attendant, the claimed method is directly counter to McCarty's teachings.

After reviewing McCarty as a whole to determine the scope and content of its disclosure, as well as the differences between McCarty's teachings and the claims at issue, it would not be obvious to modify the teachings of McCarty to arrive at the claimed invention. As indicated above, there is no motivation to modify a reference if the modification would render the prior art invention unsatisfactory for its intended purpose or change the principle of operation of the prior art invention. In the present situation, McCarty's device is specifically designed to eliminate the need of an attendant in a rental transaction. To modify

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McCarty, as suggested by the Examiner, would destroy the intended purpose of McCarty and change the principles of operation of McCarty. As such, there is no motivation to modify McCarty, and McCarty cannot render the claimed invention obvious.

The teachings of Joao and Denny do not cure the deficiencies of McCarty. Joao discloses an automated apparatus for providing an insurance contract to a person renting or leasing property. Information regarding the renter and the rental property is input into a computer system, and the computer uses this information as well as actuarial data to determine whether an insurance policy should be issued and the level of premium. Joao does not disclose the use of an attendant to facilitate multiple aspects of the transaction. Rather it is fully automated. Furthermore, the device disclosed in Joao does not appear to provide recommendations to the renter. The automated device appears to only provide an insurance quote based upon certain parameters input into the device. Consequently, Joao fails to provide any motivation to modify it's own teachings or those of McCarty to arrive at the claimed subject matter.

Finally, Denny discloses a property inspection system that systematically prompts an employee of a property management company to inspect a rented property and input condition information. In one embodiment, the inspector uses a hand held bar code reader to scan certain items within the rental property. The hand held device then prompts the inspector to input condition information.

The Examiner relies upon Denny to teach the limitation regarding inspection of the storage unit by the prospective renter. However, as indicated above, the disclosure of Denny does not teach or suggest this limitation. Specifically, Denny does not teach or suggest a manager interacting in the rental transaction. Rather, Denny teaches a system and method for an employee of a management company to systematically inspect a rental property for damage. Furthermore, there does not appear to be any teaching of providing remote access to the rental property. Consequently, Denny fails to provide any motivation to modify it's own teachings or those of McCarty or Joao to arrive at the claimed invention.

In addition to there being no motivation to make the proposed combination, the prior-art references when combined do not teach or suggest all of the claim limitations. Specifically, none of the references teach the following summarized claim limitations:

1. A customer service counter that minimizes glare;

2. Oral communication between a customer and remote manager to facilitate multiple operations in a rental transaction (including providing recommendations, providing direction regarding filling out rental agreements, and remotely verifying the rental agreement);
3. Providing a prospective customer with access to a storage unit for inspection; and/or
4. Remotely verifying information placed on a hard copy rental agreement.

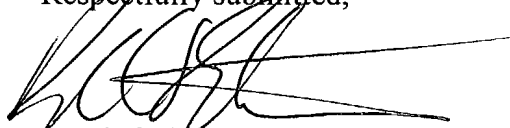
(It is noted that the Examiner did not address the last two clauses of claim 1 in the Office action.) Thus, in view of all of the above, a prima facie case of obviousness has not been established.

In light of the arguments presented, claim 1 is allowable. Claims 4-10 and 39-47 depend from claim 1 and are, therefore, also allowable for at least the same reasons as claim 1, and also because they contain additional patentable subject matter, which for the sake of brevity is not discussed.

The Applicants have amended claim 1 to clarify the means or mechanism of communication between the customer and the remote manager as well as the area viewed by the camera. Specifically, the claim now clearly indicates that the customer and the remote manager communicate through the communication link, and the area viewed by the camera is the rental agreement viewing area.

The Applicants kindly request that the Examiner call the attorneys of record in the event a telephone discussion would be helpful in advancing the prosecution of the present application.

Respectfully submitted,



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